

REMARKS

Claims 59, 70, 75 and 81 are amended. Claims 59-78 and 81-93, as amended, remain in the application with Claims 67 and 68 being withdrawn. No new matter is added by the amendments to the claims.

The Rejections:

In the Office Action dated August 23, 2007, the Examiner stated:

Pertaining to rejections under 35 USC §103(a)

Applicant argues that "assigning a unique identifying indicia" is not present in Paskowitz because Paskowitz is directed at identifying mass produced products while the present application is directed to unique individual items. This is not accurate because Paskowitz is directed at identifying items based on characteristics. The reference teaches identifying items and distinguishing them from each other based on whatever characteristics the seller and buyer choose. The assignment of a unique identifying indicia is based on those characteristics. The use of a mass produced product as an example is therefore not dispositive. If the item is being traded based on certain characteristics then the unique identifying indicia will be based on those characteristics regardless whether it is a unique item or a mass produced one. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

With regard to the argument concerning "certificate number," merely declaring that the unique identifying indicia "is an assigned certificate number" is not distinguishing. It is still a "unique identifying indicia." The claims do not delineate any functional relationship between the indicia and the certificate number, nor do they claim the certificate or certificate number in any form that gives them function and substance. In fact the certificate itself does not appear in the claims. Where does the number come from? Why is it relevant? To the extent the certificate number is alleged to represent any patentably distinguishable form or substance, the claims directed to it are incomplete for omitting essential steps.

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are

1-16514

representative of the teachings in the art and are applied to the specific limitations within the claims, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

The Examiner rejected Claims 59-66, 69-78 and 81-93 under 35 U.S.C. 103(a) as being unpatentable over Paskowitz (Paper #20060904; US Patent No. 6,377,937) in view of Mayer (Paper #20060904; US Patent No. 5,042,650) and further in view of Klearman (US Patent No. 5,311,365). The Examiner stated that Paskowitz teaches a method and system for grading and commoditizing objects, making them trade ready. Paskowitz teaches grading an object based upon a predetermined grading scale and generating a grade indicator for the object (see at least abstract, figs.1-6, column 3 lines 20-30, column 6 lines 32-58). Paskowitz teaches commoditizing the object by generating relevant textual trade data for the object and storing the relevant textual trade data in a database in a form for use in generating a trade listing for the object (see at least abstract, figs.3, 5; column 1 lines 16-34, column 6 lines 32-58, column 8 lines 32-47, line 65 - column 9 line 9). Paskowitz further teaches:

performing these steps for a plurality of objects: providing access to the relevant textual trade data in the database to sellers to generate trade listings for the objects (see at least abstract, column 6 lines 32-58); providing access to the trade listings to the sellers and to buyers within an online peer-to-peer trading environment (see at least figs.1, 6; column 1 lines 8-14, column 2 lines 50-64).

assigning a unique identifying indicia to the object: connecting the database to a host computer, connecting a remote terminal to the host computer, sending the unique identifying indicia from the remote terminal to the host computer and retrieving from the database for viewing at the remote terminal the relevant textual or digitized image trade data for the object associated with the unique identifying indicia, providing relevant trade data to at least one online trade enabling facility (see at least fig.2, column 1 lines 8-14, column 3 lines 20-30, 50-59 (retrieving and displaying product information through the Internet inherently involves a remote computer retrieving information from a database through a host computer), column 9 lines 48-60. The image or text data is descriptive material and is not functionally involved in the recited steps

1-16514

of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106). The provision of the data described can occur either in advance or contemporaneous with the trade listing); each of the unique identifying indicia is an assigned unique certificate number having a predetermined format (Please note: the format of the identifying indicia is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).).

the object is at least one of a coin a stamp a trading card, currency and a document: the stored relevant textual trade data is at least one of a plurality of item specific attributes including a certificate number, a year of mintage indicator, a Mint branch indicator, a denomination indicator, type designation, grade indicator, and grading firm identifier (Please note: in the context of this invention, the nature of the objects only affects the information presented within the descriptive material. It has no actual role in the method. The description of the object is therefore descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).

generating trade listings: from the stored relevant textual trade data in at least one trade enabling marketplace computer and providing access to the trade listings to the sellers and to buyers of the objects through computers connected to the marketplace computer (see at least abstract, figs.1, 3, 5, 6; column I lines 8-34, column 2 lines 50-64, column 6 lines 32-58, column 8 lines 32-47, line 65 - column 9 line 9).

Paskowitz teaches all of the above as noted and teaches a) associating the grade indicator with the object, b) assigning a unique identifying indicia to each of the objects, and c) a method of communicating data concerning the objects between buyers and sellers. Paskowitz however

1-16514

does not disclose encapsulating objects, associating the grade indicator with the object in a substantially permanent manner by encapsulating the object and a visual representation of the grade indicator in a tamper-evident holder and associating the assigned unique identifying indicia with the object encapsulated in the tamper-evident holder in a substantially permanent manner, printing the assigned associated unique identifying indicia onto a label and securing the printed label within the tamper-evident holder. Mayer teaches a) associating the grade indicator with the object, b) assigning a unique identifying indicia to each of the objects, and c) a method of communicating data concerning the objects between buyers and sellers. Mayer also teaches encapsulating objects, associating the grade indicator with the object in a substantially permanent manner by encapsulating the object and a visual representation of the grade indicator in a tamper-evident holder, assigning a unique identifying indicia to the object and associating the assigned unique identifying indicia with the object encapsulated in the tamper-evident holder in a substantially permanent manner, printing the assigned associated unique identifying indicia onto a label and securing the printed label within the tamper-evident holder, indicia being visibly conspicuous thereby indicating that the objects are trade ready (see at least abstract, figs.1-5). Mayer further teaches:

providing a substantially planar upper enclosure element for receiving at least partially a coin retaining inset (see at least abstract, figs.1-5).

providing a substantially planar lower enclosure for receiving at least partially a coin retaining inset (see at least abstract, figs.1-5).

providing a coin retaining insert adapted for close fitting between the upper and the lower enclosure element: the coin retaining insert having an appropriately dimensioned aperture for confining the coin: (see at least abstract, figs.1-5).

mounting the coin within the aperture of the coin retaining insert: (see at least abstract, figs.1-5).

confining the insert including the coin between the upper and lower enclosure elements: (see at least abstract, figs.1-5).

sealing the enclosure elements using sonic welding means: (see at least abstract, column 3 lines 51-68).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method and system of Paskowitz to include encapsulating objects, associating the grade indicator with the object in a substantially permanent manner by encapsulating the object and a visual representation of the grade indicator in a tamper-evident holder, assigning a unique identifying indicia to each of the objects and associating the assigned unique identifying indicia with the corresponding one of the objects encapsulated in the holder in a substantially permanent manner, printing the assigned associated unique identifying indicia onto a label and securing the printed label within the tamper-evident holder, the indicia being visibly conspicuous, as taught by Mayer, in order to verify the authenticity and value of the object being sold or traded, increasing confidence in the objects traded through the method and system and correspondingly increasing the use of the method and system in commerce.

Paskowitz in view of Mayer teach all of the above as noted and teach a) buying and selling objects in commerce, b) examining an object for the purpose of assigning a value, and c) associating a grade indicator with an object, but do not disclose preparing an object for grading and encapsulation by establishing close physical proximity to the object and enabling visual inspection of the object utilizing at least one of a jeweler's loupe and a magnifying glass, and generating a grade indicator for the object by evaluating a physical condition of the object including characteristics upon which the object is to be graded and visually examining the characteristics of the object to determine a grade of the object based upon a predetermined grading scale. Klearman teaches a) buying and selling objects in commerce, b) examining an object for the purpose of assigning a value, and c) associating a grade indicator with an object, and also teaches preparing an object for grading and encapsulation by establishing close physical proximity to the object and enabling visual inspection of the object utilizing at least one of a jeweler's loupe and a magnifying glass, and generating a grade indicator for the object by evaluating a physical condition of the object including characteristics upon which the object is to be graded and visually examining the characteristics of the object to determine a grade of the object based upon a predetermined grading scale (see at least abstract, column 1 lines 5-44). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method and system of Paskowitz in view of Mayer to further include preparing an object for grading and encapsulation by establishing close physical proximity to the

1-16514

object and enabling visual inspection of the object utilizing at least one of a jeweler's loupe and a magnifying glass, and generating a grade indicator for the object by evaluating a physical condition of the object including characteristics upon which the object is to be graded and visually examining the characteristics of the object to determine a grade of the object based upon a predetermined grading scale, as taught by Klearman, in order to create value in the items to be bought and sold in commerce, without which Paskowitz in view of Mayer would not be able to function in commerce.

The Response:

The Examiner has addressed only a portion of Applicant's argument that "a unique identifying indicia" is not present in Paskowitz. Independent Claims 59, 70, 75 and 81 each recite either "assigning a unique identifying indicia to the object" [Claim 59, step e) and Claim 81, step (d)] or "assigning a unique identifying indicia to the coin" [Claim 70, step c) and Claim 75, step (c)]. The Examiner stated that Paskowitz is directed at identifying items based on characteristics and teaches identifying items and distinguishing them from each other based on whatever characteristics the seller and buyer choose. The Examiner then states that "assignment of a unique identifying indicia is based on those characteristics." However, the Examiner failed to identify where in Paskowitz it is stated that a "unique identifying indicia" is assigned to an object. The characteristics discussed by the Examiner are identified by Paskowitz as including dimensions, color, function, reliability, material content, delivery schedule and price. (Col. 3, Line 66 through Col. 4, Line 3) The dimensions, color, function, reliability, and material content characteristics each have a "value" that is determined by the structure of the object. These values are not "assigned" and there is no suggestion that the values are unique to one object. The values of the delivery schedule and price characteristics are assigned, but there is no suggestion in Paskowitz that these values are unique to one object. Note that Paskowitz would not require the Boolean search step 17 (Fig. 2) if a "unique identifying indicia" is assigned to the object.

The Examiner stated that the use of a mass produced product as an example is therefore not dispositive and, if the item is being traded based on certain characteristics then the unique identifying indicia will be based on those characteristics regardless whether it is a unique item or a mass produced one. Applicant agrees that the unique identifying indicia could be based upon

1-16514

the characteristics. However, Paskowitz does not disclose a "unique identifying indicia" assigned to an object. Furthermore, Applicant's claims do not require the "unique identifying indicia" to be based upon the characteristics of the object.

Independent Claims 59, 70, 75 and 81 also recite that the "unique identifying indicia" is associated with the object by encapsulation or confining in a tamper-evident holder. Paskowitz does not disclose encapsulation or confining an indicia of any of the characteristic values in a tamper-evident holder.

As stated above, each of the independent Claims 59, 70, 75 and 81 includes of step of assigning a unique identifying indicia with the object such as a coin. This is an important feature of Applicant's inventive method because the objects are unique. It is crucial to the trading process that the seller identify a specific object and that the buyer be able to identify the same object.

In contrast, Paskowitz provides a method and a system for locating mass produced products that satisfy user requirements. The user cannot select a specific one of a plurality of identical products that satisfy the requirements. Using the Paskowitz example of a resistor in a TV set (Col. 4, Lines 10-23), the system will locate one or more sources of a resistor that meets the requirements, but the user can't identify a specific one of thousands of identical resistors that may be available.

Applicant's claims recite a method of assuring that a unique object, such as a coin, is available for display and listing for sale in a manner that can be positively identified by buyers. Paskowitz does not show or suggest such a method.

The Examiner cited Mayer for teaching a) associating the grade indicator with the object, b) assigning a unique identifying indicia to each of the objects, and c) a method of communicating data concerning the objects between buyers and sellers. The Examiner stated that Mayer also teaches encapsulating objects, associating the grade indicator with the object in a substantially permanent manner by encapsulating the object and a visual representation of the grade indicator in a tamper-evident holder, assigning a unique identifying indicia to the object and associating the assigned unique identifying indicia with the object encapsulated in the tamper-evident holder in a substantially permanent manner, printing the assigned associated

unique identifying indicia onto a label and securing the printed label within the tamper-evident holder, indicia being visibly

Mayer shows a "tamperproof" coin case with a certificate 45 that provides information for authenticating the coin in terms of identification and description of quality. (See Col. 3, Lines 3-18) Thus, by observing the certificate, one could determine the coin supplier, the type of coin, the coin grade, and that the grade is certified by the supplier. However, Mayer does not disclose that the certificate contains a unique identifying indicia associated with the coin.

Even if it were obvious to combine Paskowitz with Mayer, such a system would lack the unique identifying indicia associated with the object recited in all of Applicant's claims.

Mayer fails to teach or suggest any solution whatsoever to the problem facing the Applicant at the time of invention. The general problem facing the inventor was the difficulty he experienced when attempting to sell encapsulated coins via the World Wide Web component of the Internet. The applicant as inventor recognized that significant impediments to the online listing process needed to be overcome in order to generate trade listings in a less cumbersome and more streamlined manner. Ultimately, Applicant realized that one way to solve the problem was to improve the method by which coins are encapsulated, thereby making the encapsulated coins trade ready. The improved method claimed by Applicant was unknown in the art at the time of invention.

Applicant respectfully submits that no motivation, suggestion or teaching can be found within the disclosure of Mayer whereby a person possessing ordinary skill in the art would have concluded that storing both graphical and textual data in a database may provide future utility such as facilitating the generation of trade listings for sellers desiring to exchange certified coins via the World Wide Web. Applicant further submits that Mayer could not anticipate the problems facing the Applicant since the disclosure by Mayer predates the public implementation of web based peer-to-peer trade listing services such as eBayTM and the like.

The Examiner cited Klearman for teaching a) buying and selling objects in commerce, b) examining an object for the purpose of assigning a value, and c) associating a grade indicator with an object, and also teaches preparing an object for grading and encapsulation by establishing close physical proximity to the object and enabling visual inspection of the object utilizing at least one of a jeweler's loupe and a magnifying glass, and generating a grade indicator for the

1-16514

object by evaluating a physical condition of the object including characteristics upon which the object is to be graded and visually examining the characteristics of the object to determine a grade of the object based upon a predetermined grading scale (see at least abstract, column 1 lines 5-44).

However, Klearman does not disclose that the certificate contains a unique identifying indicia associated with the coin.

Applicant amended Claims 59, 70, 75 and 81 to clarify the differences between Applicant's claimed invention and the cited prior art by adding "which unique identifying indicia does not represent the characteristics of the object/coin". Thus, even if the Paskowitz object characteristics could be considered "a unique identifying indicia", Applicant's "unique identifying indicia" is not based upon the object characteristics.

In view of the amendments to the claims and the above arguments, Applicant believes that the claims of record now define patentable subject matter over the art of record. Accordingly, an early Notice of Allowance is respectfully requested.